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EXAMINER				
KHAN, ASHER R				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/803,987

**Applicant(s)**

FRIEDMAN, ANDREW

**Examiner**

ASHER KHAN

**Art Unit**

4134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 10/19/2006/8/30/2004  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Inventor's Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. **Claims 1-18** are objected to because of the following informalities: Acronym "EDL" cited in claim 1, line 3, claim 13, line 2, claim 15, line 4, claim 16, line 4, claim 17, line 4 and claim 18, line 4 should be changed to -- Edit decision list(EDL) --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The recitation of "EDL element which is positioned in the sequence of EDL elements prior to a first EDL element in the ordered sub-set of the EDL elements" in claim 5, page 29, lines 1-2 is not supported in the specification. Specification only discloses in paragraph 62 that track control attributes that serve to control commencement and termination of the dependent media item.

From the best understanding of "EDL element which is positioned in the sequence of EDL elements prior to a first EDL element in the ordered sub-set of the

EDL elements" (See Fig 2A, EDL elements are ordered in a sequence having a first EDL element 200)(Col. 2 lines 43-65)

4. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The recitation of "EDL element which is positioned in the sequence of EDL elements subsequent to a final EDL element in the sub-set of the EDL elements" in claim 7, page 29, lines 11-12 is not supported in the specification. Specification only discloses in paragraph 62 that track control attributes that serve to control commencement and termination of the dependent media item.

For best understanding of claims 5 and 7 "EDL element which is positioned in the sequence of EDL elements subsequent to a final EDL element in the sub-set of the EDL elements", (See Fig 2A, EDL elements are ordered in a sequence having final EDL element 240)(Col. 2 lines 43-65) on the following rejection.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

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Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

5. **Claims 15-16** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 15 and 16 define a set of computer program modules comprising computer program code embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed a set of computer program modules comprising computer program code can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The recitation of "computer program" should be changed to -- computer program stored in a memory – in claims 15-16 to make claim statutory.

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6. **Claim 17** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 17 is drawn to functional descriptive material recorded on a computer readable medium. Normally, the claim would be statutory. However, the specification, at page 3 paragraph 49 and 51 defines the claimed computer readable medium as encompassing statutory media such as a "ROM", "hard drive", "optical drive", etc, as well as ***non-statutory*** subject matter such as a ***"signal"*** .

A "signal" embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claim 1-7 and 12-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,970,639 B1 to McGrath et al "McGrath".**

As to claims 1, 15, 16 and 17, McGrath discloses a method of generating a dependent media item, said method comprising the steps of:  
arranging, in an order, a sequence of EDL elements (portions of source content) for a corresponding sequence of media items (source content) in a source media track, wherein at least an ordered sub-set of the sequence of EDL elements (subset of portions of source content) are associated with track control attributes (template metadata) for the dependent media item (edited content sequence)(Col. 1, lines 29--67; Col 2, lines 1-67; Col. 3 lines 1-24); and generating the dependent media item(edited content sequence) dependent upon at least some of said track control attributes (metadata) and the order in which the sub-set of EDL elements (subset of portions of source content) is arranged (Col. 1, lines 29--67; Col 2, lines 1-67; Col. 3 lines 1-24).

As to claims 2 and 14, McGrath further disclose steps of:  
re-ordering the sub-set of EDL elements (Col. 2, lines 43-65).  
re-generating the dependent media item (edited content sequence) dependent upon at least some of said track control attributes (template metadata) and the order in which the sub-set of EDL elements is re-ordered (Col. 2, lines 43-65).

As to claim 3, McGrath further discloses wherein the re-ordering step comprises deletion of at least one of the sub-set of EDL elements (Col. 2, lines 43-65; selecting one take out of multiple takes using good shot marker and producing edited content that are shorter than original).

As to claim 4, McGrath further discloses wherein commencement of the dependent media item (edited content sequence) is dependent upon a track control

attribute (template metadata) associated with an EDL element (portions of source content) in the sub-set of the EDL elements (subset of portions of source material (Col. 2, lines 43-65)(Col. 7, lines 46-67; Col. 8, lines 1-14)(Fig.2, 4A)(Col. 10, lines 40-67).

As to claim 5, McGrath further discloses wherein commencement of the dependent media item(edited content sequence) is dependent upon a track control attribute (template metadata) associated with an EDL element (portions of source content) which is positioned in the sequence of EDL elements prior to a first EDL element in the ordered sub-set of the EDL elements(subset of portions of source material) (Col. 2, lines 43-65)(Col. 7, lines 46-67; Col. 8, lines 1-14)(Fig.2, 4A)(Col. 10, lines 40-67).

As to claim 6, McGrath further discloses wherein termination of the dependent media item (edited content sequence) is dependent upon a track control attribute associated with an EDL element in the sub-set of the EDL elements (Col. 2, lines 43-65)(Col. 7, lines 46-67; Col. 8, lines 1-14)(Fig.2, 4A)(Col. 10, lines 40-67).

As to claim 7, McGrath further discloses wherein termination of the dependent media item (edited content sequence) is dependent upon a track control attribute (template metadata) associated with an EDL element (portion of source content) which is positioned in the sequence of EDL elements subsequent to a final EDL element in the sub-set of the EDL elements. (Col. 2, lines 43-65)(Col. 7, lines 46-67; Col. 8, lines 1-14)(Fig.2, 4A)(Col. 10, lines 40-67).



As to claim 12, McGrath further discloses wherein a said track control attribute comprises one of an attribute to activate (Fig. 2, 200) the dependent media item and an attribute to deactivate (Fig. 2, 240) the dependent media item (Fig. 2).

As to claim 13 and 18, An apparatus for generating a dependent media item, said apparatus comprising:

an editor for (i) arranging a sequence of EDL elements (portions of source content) in an order, wherein at least an ordered sub-set of the EDL elements (subset of portions of source content) are associated with track control attributes (template metadata) for the dependent media item (Col. 1, lines 29--67; Col 2, lines 1-67; Col. 3 lines 1-24), and (ii) producing a sequence of media items (Source content) in a source track dependent upon at least some of the sequence EDL elements (portions of source content) (Col. 1, lines 29--67; Col 2, lines 1-67; Col. 3 lines 1-24); and  
means for generating the dependent media item (edited content sequence) dependent upon at least some of said track control attributes (metadata) and the order in which the sub-set of EDL elements is arranged (Col. 1, lines 29--67; Col 2, lines 1-67; Col. 3 lines 1-24).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claim 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,970,639 B1 to McGrath et al "McGrath" in view of U.S. Patent 5,801,685 to Miller et al "Miller".**

As to claim 8, McGrath et al fail to disclose wherein the dependent media item is a graphical overlay that is copied from a template which is referenced by one of said track control elements.

Miller discloses wherein the dependent media item (Text Script) is a graphical overlay (Fig. 3) that is copied from a template which is referenced by one of said track control elements (control characters)(Col 3 lines 38-67; Col 4 lines 1- 52)(Fig. 3)(Col. 1 lines 10-67; Col 2 lines 1-20).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine McGrath with the teaching of Miller. Rationale to have combined would be that all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

As to claim 9, Miller further discloses wherein the copy of the template is transformed to thereby form the dependent media item.

Miller further discloses wherein the copy of the template is transformed to thereby form the dependent media item (Text Script) (Col 3 lines 38-67; Col 4 lines 1- 52)(Fig. 3) (Col. 1 lines 10-67; Col 2 lines 1-20).

As to claim 10, McGrath fails to disclose wherein a said media item in the source track comprises a copy of a media item which is referenced by a corresponding said EDL element in the sequence.

Miller further discloses wherein a said media item (video Clip) in the source track comprises a copy of a media item which is referenced by a corresponding said EDL element (Start time of the clip) in the sequence (Col 3 lines 38-67; Col 4 lines 1- 52)(Fig. 3) (Col. 1 lines 10-67; Col 2 lines 1-20).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine McGrath with the teaching of Miller. Rationale to have combined would be that all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

As to claim 11, Miller further discloses wherein the copy of the media item is transformed to thereby form the media item in the source track.

Miller further discloses wherein the copy of the media item is transformed to thereby form the media item in the source track (Col 3 lines 38-67; Col 4 lines 1- 52)(Fig. 3) (Col. 1 lines 10-67; Col 2 lines 1-20).

Therefore it would have been obvious to combine McGrath with the teaching of Miller to make the modifications as claimed in claims 8-11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on Monday-Friday 9:30 am - 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lun Yi can be reached on (571)272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. K./  
Examiner, Art Unit 4134

/LUN-YI LAO/  
Supervisory Patent Examiner, Art Unit 4134